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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,007	11/21/2001	Judith C. Clark	040094/0101	9546
22428	7590	12/01/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			SPERTY, ARDEN B	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/989,007

**Applicant(s)**CLARK, JUDITH C. TH**Examiner**

Arden B. Sperty

**Art Unit**

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 21-23, 34 and 43-88 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 14, 21-23, 43, 50-52, 56-59, 81 and 82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-13, 34, 44-49, 53-55, 60-80, 83-88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **FINAL OFFICE ACTION**

### ***Status of the Claims***

1. The status of the claims is as follows:

Examined- 8-13, 34, 44-49, 53-55, 60-80, 83-88;

Withdrawn- 1-7, 14, 21-23, 43, 50-52, 56-59, 81, 82;

Canceled- 15-20, 24-33, 35-42.

Of the examined claims, claims 34, 47, 60, 62, 63, and 65 were previously withdrawn, but are currently examined due to the amendment submitted 9/13/04. Of the withdrawn claims, although claim 43 was amended and new claims 81 and 82 were added, these claims are not seen to read on the currently elected invention. This election by original presentation is detailed below in the section titled *Election/Restriction*.

2. Applicant's amendments and accompanying remarks filed 9/13/04 have been entered and carefully considered. Applicant's amendment is not found to patentably distinguish the claims over the prior art, and Applicant's arguments are not found persuasive of patentability for reasons set forth herein below.

### ***Election/Restrictions***

3. Amended claim 43 and newly submitted claims 81 and 82 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 43 remains restricted per the original restriction of 3/11/03.

Claim 81 is grouped with claim 43 for restriction purposes. Claim 82 is restricted per the restriction dated 5/12/04, and is grouped with Species 2.

4. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 43, 81 and 82 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. This application contains claims 1-7, 14, 21-23, 43, 50-52, 56-59, 81, and 82 drawn to nonelected inventions. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Objections***

6. Claim 46, is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of the claim from which it depends. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The examiner does not see how the structure of claim 46 differs from that of claim 44.

7. Claims 65, 72, 74, 76-79 and 88 do not contain any further structural limitations than the claims from which they depend:

The process limitations of 65, 78 and 79 are considered, but are not seen to add structural detail.

The "channel that is depressed" in claim 72 is not seen to further limit the "channel" of claim 70. Similarly regarding claim 88, the channel forming a groove is not seen to further limit the channel of claim 12.

Claim 74 does not further limit claim 73, since claim 73 already requires an opening.

Claims 76 and 77 do not further limit the structure of claim 73.

***Claim Rejections - 35 USC § 112***

8. All 35 USC 112 rejections stated in the previous action are **withdrawn** per Applicant's amendments to the claims, including the rejection of the inclusion of new matter. Specifically regarding claims 58 and 59, the terminology used in the newly amended claims is taken from the specification, as required, resulting in withdrawal of the previously stated 35 USC 112 rejection. However, the newly amended structures have not been assessed for enablement since the claims remain withdrawn.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. It is critical or essential to the practice of the invention to indicate which side of the backer the first adhesive and/or mechanical fastener is attached to (line 8). See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

10. Claims 75 and 80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. All elements of the Markush group are not found in the specification. If Applicant wishes to contest this, he is required to cite page and line numbers for each element of the Markush group.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 10 is rejected under 35 USC 112, second paragraph, because without indication of which side of the backer the first adhesive and/or mechanical fastener is on, the rest of the claim structure is unclear. The structure of the group of claims 10, 11 and 13 is the same as that of claim 12. The Examiner has made a good faith effort to draw each element of each claim and determine a difference, however none can be seen.

13. Newly amended claim 64 is rejected under 35 USC 112, second paragraph, because the structure is unclear. Specifically, reference to one cut-out being on the first side of the backer and one cut-out being on the second side of the backer, is unclear. A cut-out is understood to go all the way through an object, therefore the cut-out is on both sides at the same time. The difference between the two cut-outs of the claim is

unclear. By looking at an object with two cut-outs, how does one determine which side each cut-out is on?

14. Claims 48 and 49 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are internally inconsistent because, as amended, claim 48 recites that it is dependent on "the method according to claim 47," although claim 47 is not a method claim. Claim 49 recites that it is dependent on "the method according to claim 48," although claim 48 is not a method claim.

15. Claims 55 and 73 are rejected under 35 U.S.C. 112, second paragraph, as indefinite. The difference(s) between the claimed structures is (are) unclear. The Examiner has made a good faith effort to draw each element of each claim and determine a difference, however none can be seen. The same rejection applies to claims 61 and 64; a difference between the claimed structures cannot be ascertained, despite careful consideration. Applicant is advised to cancel claims with duplicate scope. Throughout the process of amending and adding new claims, Applicant has created a set of claims with muddled terminology and scope.

16. Claims 76 and 77 are indefinite because the difference between a portion of the affixing element being disposed within an opening, and an end of the affixing element fitted through an opening, is unclear. Applicant is respectfully requested to indicate which figure each claim corresponds to.

17. Regarding claim 80, what is the difference between double stick tape and double sided tape? What are "sticky backing" and "double sided reusable adhesive tape non-adhesive tape portion"?
18. Claim 83 is rejected under 35 U.S.C. 112, second paragraph, as indefinite because it is not clear what the structural difference is between "adhering" in claim 83 and "attaching," in line 15 of claim 8 from which it depends. The difference in semantics is slight, if any, therefore the implied structure is not seen to be any different than that of claim 8.
19. Claims 84 and 86 are indefinite. With what element is the backer "integral"? And what material does "same" refer to?

***Claim Rejections - 35 USC § 102***

20. Claims 8, 9, 12, newly amended claims 10, 11, 13, 34, and newly added claims 79, 83 and 85 remain rejected under 35 U.S.C. 102(b) as being anticipated by Mathis (5566477), **as stated in the previous office action.**

Claims 10, 11 and 13 require no more structure than claim 12. Since claim 12 is obvious, likewise are claims 10, 11 and 13.

Claim 34 requires no more structure than claim 8. Since claim 8 is obvious, likewise is claim 34.

Regarding claim 79, the final product of the claim is that which is examined. Therefore, there are no further structural limitations in this claim than in the claim from which it depends.



Regarding claim 83, the difference in semantics between “adhering” in claim 83 and “attaching,” in line 13 of claim 8 from which it depends, is slight, if any. Therefore the implied structure is not seen to be any different than that of claim 8 and the claim is anticipated by the previously stated rejection.

The limitation of claim 85 is met by the flat shoelace cover **28** of the Mathis reference.

21. Now regarding the arguments presented against the rejection of the claims over Mathis, Applicant first argues that the shoelace is not used to affix the shoelace cover to the shoe, but rather the first and second straps, riveted to the shoe, are used to affix the shoelace cover to the shoe. This argument is not persuasive because all of the shoelace, first strap, and second strap affix the shoelace cover to the shoe. The loop **40** is considered part of the shoelace cover, and the shoelace goes through loop **40** (through an opening on one side and through an opening on the other side). The ends are tied and coupled.

22. Applicant further argues, on page 28, that the shoelace cover does not provide backing or stability for the shoe or laces. However, functional requirements such as these, which depend on the ultimate intended use, are given little weight, since the patentability of a product relies on the structure, not the ultimate intended use.

23. Arguments regarding claim 12 are further unpersuasive. As was explained in the Interview of 9/09/04, the loop **40** forms a channel on the second surface of the backer,

and allows for passage of the shoelace. Therefore, the shoelace (affixing element) is held in place within the channel/loop **40**.

24. The 35 U.S.C. 102(b) rejection of claims 55, 61, 64 and 66, as anticipated by the standard definition of Velcro, is **withdrawn** per Applicant's amendment to the claims to positively include structural elements beyond those of traditional Velcro.

***Claim Rejections - 35 USC § 103***

25. Claims 8, 9, 12, 44-46, newly amended claims 47, 55, 61-64, 66, and new claims 67-80, 87, and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanback (5709013) in view of Sowell (5857469), supported by USPN's 3751769, 6516853, 3301266 and 6047708, **as stated in the previous office action**.

Claim 47 requires no more structure than claim 8. Since claim 8 is obvious, likewise is claim 47.

Claims 55, 61-64, and 88 require no more structure than claim 12. Since claim 12 is obvious, likewise are claims 55, 61-64, and 88. It is interpreted that two cut-outs are intended in claim 64. Claim 67 is further rejected as obvious, according to the combination of Stanback and Sowell as stated in the previous office action. It would have been obvious to one of ordinary skill in the art to form the channel from the edge of one hole in the support to the edge of the other hole in the support of the combination of Stanback and Sowell references. While the Stanback reference is not concerned with the shape of the support or the openings, changing the shape of an object without an

effect on the functionality of the object, is regarded as a choice of design. In the instant case, changing the shape of the support and openings taught by Stanback would not interfere with the functionality of the device. Therefore, claims 68, 69 and 87 are obvious in view of the prior art.

The only apparent structural difference between claims 70 and 55 seems to be in the more detailed description of the first and second adhesive and/or mechanical fastener. However, the limitations of claim 70 and 72 are anticipated by the Velcro of the previously stated rejection. The process limitations of claim 71 are not seen to further limit the structure of claim 70. The final product of the claim is that which is examined. Therefore, there are no further structural limitations in claim 71 than in the claim from which it depends.

As stated above, claim 73 is rejected under 35 USC 112, second paragraph, as being drawn to the same structure as claim 55, therefore the same art rejection applies to both claims. Claims 74, 76-79 are further anticipated as they do not further limit claim 73. Claim 75 is anticipated by the elastic band of Stanback. Claim 80 is anticipated by the Velcro of the Stanback/Sowell combination of references.

26. Now regarding the arguments presented against the rejection of the claims, arguments at the top of page 30 of Applicant's response, regarding claims 44-46, are unpersuasive. Applicant's allegation, that the location of the coupled ends is critical to the durability of the claimed attachment device, is not only unsupported, but further is not an argument against the obviousness rejection of the combined references. Even if

Applicant's allegations were true, would it not have been obvious to another of ordinary skill in the art practicing the invention of Stanback?

27. Applicant then seems to assert that an ornamental article similar to a broach is not an ornament. The argument is unpersuasive, as it finds no basis in logic. Applicant even cites location in the reference referring to "ornamental articles."

28. Arguments regarding the combination of Stanback and Sowell are further unpersuasive. Articles "similar to a broach" are seen to encompass items of similar weight, shape, and size, although not necessarily comprising a pin. As stated in the office action, to eliminate safety concerns associated with pins, it would have been obvious to use a pin-free attachment mechanism. Accordingly, the combination of Stanback and Sowell, both drawn to interchangeable ornaments of similar weight, shape and size, is obvious. The Examiner agrees with Applicant's deduction (on page 32) that Stanback's attachment device does not have any pins. For this reason, the Velcro of the Sowell reference would not have a negative effect on the function or operation of Stanback's device.

29. Applicant's spurious arguments on page 31, about the curved surface of Stanback's support device not being conducive to receiving Velcro, are completely speculative. Firstly, references are not restricted to embodiments shown in drawings. Secondly, the barrette of Sowell has a curved surface and is still functional with Velcro. Thirdly, Velcro is flexible, so there is no reason to assume that the curvature of Stanback's support device renders it incompatible with Velcro.

30. Applicant further argues that Stanback appears to consider Sowell's type of attachment as being undesirable, however Applicant is misconstruing the rejection. Stanback teaches against "adhesives, magnets and the like" for attaching the support of Stanback to an article of clothing, however the rejection never proposed to use Sowell to attach the support of Stanback to an article of clothing. The rejection stated that it was obvious to use Sowell to attach an ornament to the support.

31. At the bottom of page 32 Applicant argues that a channel portion would not have been obvious based on the teachings of Stanback alone. However, non-obviousness cannot be shown by attacking references individually. It is the examiner's position that the combination set forth above would have been obvious to one of ordinary skill in the art, as stated in the previous office action.

32. Claims 48, 49, 53, 54, and amended claims 60 and 65, are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanback in view of Sowell as applied to claims 47 and 55 above, and further in view of Bries (6572945), **as stated in the previous office action.**

Claim 60 is anticipated by the previously stated rejection.

The process limitations of amended claim 65 are not seen to further limit the structure of claim 55. The final product of the claim is that which is examined. Therefore, there are no further structural limitations in claim 65 than in the claim from which it depends.

33. Regarding Applicant's arguments, Applicant apparently has misconstrued the rejection. The adhesive strip of Brie would clearly not eliminate the structure of Stanback where Brie's adhesive is used to attach the Velcro of Sowell to the structure of Stanback. As stated in the rejection, the releasable adhesive of Brie would be an obvious choice for attaching the Velcro of Sowell, so as not to destroy the structure of Stanback.

34. On page 33 Applicant again cites the previous position against the combination of Stanback and Sowell. The examiner's position has already been stated, and is not repeated.

### ***Conclusion***

35. The examiner has attempted to respond to each of Applicant's arguments in turn, to best prepare the case for appeal if desired.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

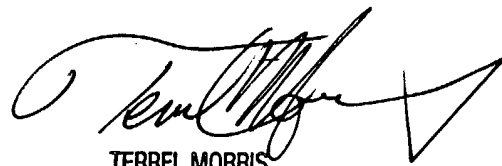
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Arden B. Sperty  
Examiner  
Art Unit 1771

November 21, 2004



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